

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: Unknown

Jin-Xing Li et al.

Examiner: Unknown

Serial No.: 10/528,765

Filed: September 18, 2003

For: TWO LAYER LTO TEMPERATURE OXIDE BACKSIDE SEAL FOR A WAFER

Attorney Docket No.: WSAG 0107 PUSA

REQUEST FOR RECONSIDERATION OF PETITION
UNDER 37 C.F.R. § 1.47(a)

Mail Stop Petition
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Joint inventor Boon-Koon Ow requests reconsideration of the previously filed petition to make this application on behalf of joint inventor Jin-Xing Li pursuant to 37 CFR 1.47(a), MPEP §409.03(a), MPEP §409.03(d), and MPEP §409.03(e).

Exhibit A, which has previously been submitted, is the Declaration signed by joint inventor Boon-Koon Ow to serve as "[a]n oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank" to be treated "as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated." MPEP §409.03(a)(A).

Exhibit B, which has previously been submitted, is a letter sent on December 1, 2005 to missing joint inventor Jin-Xing Li by Applicants' representative, James Proscia. Exhibit B, as marked in the upper right corner, was returned on December 23, 2005. This letter was unsuccessfully sent to Mr. Li at his last known address via DHL Worldwide Express (previously submitted Exhibit C). Previously submitted Exhibit D provides a series of e-mails between Mr. Proscia's secretary and Mr. Li's former employer, Siltronic AG verifying Mr. Li's last known address. As set forth in Exhibit D, Mr. Li's last known address is BLK 722 Pasir Ris St. 72, #02-123, Singapore 510722.

CERTIFICATE OF ELECTRONIC FILING

This paper, including all enclosures referred to herein, is being electronically filed with the U.S. Patent & Trademark Office EFS-Web System on: September 18, 2006.

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On November 11, 2005, Dr. Wolfgang Staudacher of Siltronic AG's Corporate Intellectual Property department, attempted unsuccessfully to ascertain Jin-Xing Li's current address by contacting co-inventor Boon-Koon Ow. (see Exhibit E, attached hereto).


As suggested by the Examiner, Applicants' representative, James Proscia, performed an Internet search to confirm the lack of information regarding the current address of joint inventor Jin-Xing Li (see Exhibit F, attached hereto). Specifically, a search utilizing the Yahoo search engine was used to locate a suitable phonebook-like directory in Singapore. This search identified a single people locating search engine for Singapore - <http://www.yellowpages.com.sg/ryp/jsp/contact.jsp>. Although the URL uses the term "yellow pages," people locating services are also provided. A search for joint inventor Jin-Xing Li was not successful. Moreover, although there is no indication that Mr. Li is in the United States, a search of several U.S.-based people finder websites were also unsuccessful in locating joint inventor Jin-Xing Li. (www.switchboard.com, www.infospace.com, www.dogpile.com).

Applicants believe that the requirements of 37 C.F.R. § 1.132 are fulfilled. Applicants respectfully request that the present Application be allowed to go forward and the pending petition under 37 C.F.R. § 1.47(a) be granted.

Please charge any additional fees or credit any overpayment as a result of filing this paper to Deposit Account No. 02-3978.

Respectfully submitted,
Jin-Xing Li et al.

By:


James W. Proscia
Registration No. 47010
Attorney/Agent for Applicant

Date: September 18, 2006

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400; Fax: 248-358-3351

Exhibit E

From: "Staudacher, Dr. Wolfgang" <Wolfgang.Staudacher@siltronic.com>
To: "Ow, Boon-Koon" <boon-koon.ow@siltronic.com>
Date: 11/22/2005 3:03:39 AM
Subject: WG: Your Ref.: SS10201 (Our File: WSAG 0107 PUSA)

Dear Mr.Ow,

kindly confirm that the current place of domicile of co-inventor Jin-Xing Li is still unknown. Furthermore, please let me know if your address changed in the meantime.

BLK 221 Pasir Ris St. 21, #11-108 Singapore 510221

Finally, kindly confirm your Singaporean citizenship, as well.

Thank you in advance.

Best regards,

Wolfgang Staudacher

DR. WOLFGANG STAUDACHER
 CORPORATE INTELLECTUAL PROPERTY

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Response Under 37 C.F.R. § 1.116 -
Expedited Procedure - Examining Group 1713

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: Unknown

Jin-Xing Li et al.

Examiner: Unknown

Serial No.: 10/528,765

Filed: September 18, 2003

For: TWO LAYER LTO TEMPERATURE OXIDE BACKSIDE SEAL FOR A WAFER

Attorney Docket No.: WSAG 0107 PUSA

DECLARATION UNDER 37 C.F.R. § 1.132

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Office of PCT Legal Administration

Sir:

I, James W. Proscia, do hereby declare and state as follows:

1. I represent Siltronic AG in the above captioned case. Siltronic AG is a German company having a place of business located in München Germany.

2. I am familiar with the present application, U.S. Serial No. 10/528,765, and the steps taken prior to my involvement attempting to locate Mr. Jin-Xing Li

3. On or about, December 1, 2005, I instructed my secretary, Denise Sinnhuber to prepare and send a letter to the last known address for Jin-Xing Li requesting

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execution of the Assignment and Declaration for the above referenced case. Delivery of these items was not successful.

4. On or about Sept. 12, 2006, I confirmed the Mr. Jin-Xing Li's lack of availability by performing an Internet search. Specifically, a search utilizing the Yahoo search engine was used to locate a suitable phonebook-like directory in Singapore. This search identified a single people locating search engine for Singapore - <http://www.yellowpages.com.sg/iyp/jsp/contact.jsp>. A search for joint inventor Jin-Xing Li using this people locator was not successful. I also attempted to find Mr. Li by using several U.S.-based people finder websites. Similarly, these attempts were also unsuccessful in locating joint inventor Jin-Xing Li. (www.switchboard.com, www.infospace.com, www.dogpile.com).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.



Dr. James W. Proscia

Dated: September 18, 2006



02 OCT 2006

22045
BROOKS KUSHMAN P.C.
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Twenty-Second Floor
Southfield, MI 48075

In re Application of
Li *et al*
U.S. Application No.: 10/528,765
PCT No.: PCT/EP2003/010410
Int. Filing Date: 18 September 2003
Priority Date: 25 September 2002
Attorney Docket No.: 0WSAG0107PUSA
For: TWO-LAYER LTO TEMPERATURE
OXIDE BACKSIDE SEAL FOR A
WAFER

DECISION

This decision is in response to applicants' "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" filed 18 September 2006.

BACKGROUND

On 18 July 2006, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants failed to satisfy item (2) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 18 September 2006, applicants filed the renewed petition which was accompanied by, *inter alia*, a declaration of James W. Procia and a copy of an email dated 22 November 2005.

DISCUSSION

As previously noted, a petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Items (1), (3) and (4) of 37 CFR 1.47(a) were completed in the initial petition.

Regarding item (2), the 37 CFR 1.47(a) claims that joint inventor, Jin-Xing Li cannot be located. In the initial petition, applicant submitted evidence that they attempted to locate the nonsigning inventor by contacting the former employer of Mr. Li.

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However, petitioner did not provide a statement of facts (by the person having firsthand knowledge) outlining the steps taken to locate the whereabouts of the nonsigning inventor. Moreover, there was no evidence that a search of phone or internet records was even attempted to locate Mr. Li.

In the renewed petition, the 37 CFR 1.47(a) applicant has submitted a declaration of James W. Proscia who claims that he attempted to send a copy of the declaration and assignment to the last known address of the nonsigning inventor. Mr. Proscia states that "[d]elivery of these items was not successful." No documentary evidence of this claim was submitted in the renewed petition.

Mr. Proscia also claims that he attempted to locate the address of the nonsigning inventor using the internet but was unsuccessful. A yellow page search based in Singapore was cited. Petitioners also used three U.S. based people finder websites. However, petitioners again submitted no documentary evidence to substantiate this account.

This is still insufficient. To demonstrate that a diligent effort was made to locate the nonsigning inventor. Copies of all documentary evidence, including internet searches and postal receipts should be filed to meet the requirements of section 409.03(d) of the MPEP. Moreover, the use of a yellow page directory to locate an individual instead of a white page directory is also questioned. Item (2) of 37 CFR 1.47(a) is still not satisfied.

CONCLUSION

For the reasons discussed above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


James Thomson

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10/528,765

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